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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86268913
Applicant	Eveready Battery Company, Inc.
Applied for Mark	BANANA BOAT
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Date	06/24/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of:	:	
Eveready Battery Company, Inc.	:	
	:	
Serial No.: 86/268,913	:	Examining Attorney: Esther Felicia Queen
	:	
Filed: May 1, 2014	:	Law Office: 111
	:	
Mark: BANANA BOAT	:	

APPLICANT'S APPEAL BRIEF

1.0 Introduction

Eveready Battery Company (“Applicant”) seeks to register the mark BANANA BOAT for *air fragrancings preparations; room fragrances* in International Class 3 (collectively, the “Applied-for Products”). The Examining Attorney requests a disclaimer of the term BANANA because it is purportedly merely descriptive of a feature of the Applied-for Goods. The Examining Attorney has maintained the disclaimer requirement and has made the same final. Pursuant to a Notice of Appeal filed on June 22, 2015, Applicant appeals the Examining Attorney’s refusal to register BANANA BOAT without the requested disclaimer.

2.0 Statement of the Relevant Facts

On May 1, 2014, Applicant filed an application to register the mark BANANA BOAT for the Applied-for Products, based on intent to use under Lanham Act Section 1(b).

In the first Priority Office Action, dated July 25, 2014, the Examining Attorney found no conflicting prior marks, but refused registration of the mark BANANA BOAT unless the word BANANA was disclaimed. The Examining Attorney stated that BANANA “merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services.”

Applicant responded on December 18, 2014 by traversing the disclaimer requirement and submitting that the word BANANA, when used in connection with the Applied-for Products, in the manner and context at issue, is not descriptive, and does not convey any immediate idea or concrete information about the Applied-for Products. The identification of goods does not refer to bananas or banana scents, and this is an intent to use application.

The Examining Attorney issued a final Office Action on January 7, 2015, maintaining the disclaimer requirement. In the final Office Action, the Examining Attorney maintained the position that the word BANANA merely describes a feature of the Applied-for Products, and thus is an unregistrable component of the mark.

This is an appeal from that final Office Action requiring the disclaimer of the word BANANA.

3.0 Summary of the Issues on Appeal

In this appeal, Applicant respectfully requests that the Trademark Trial and Appeal Board (the “Board”) reverse the Examining Attorney’s request for a disclaimer, for the following reasons: (1) the term BANANA is not merely descriptive of the Applied-for Products; (2) the Examining Attorney has not established a prima facie case that the term BANANA is merely descriptive of the Applied-for Products; (3) third-party evidence supports a finding that BANANA is not descriptive when used in connection with the Applied-for Products; (4) BANANA BOAT is a unitary mark that should be viewed as a whole, and not dissected into its component parts; and (5) any doubts as to descriptiveness must be resolved in Applicant’s favor.

For these reasons, which are discussed in detail below, Applicant submits that the word BANANA, when used in the manner and context at issue, is not merely descriptive of the

Applied-for Products. Therefore, Applicant requests that the Board overturn the disclaimer requirement and direct the Examining Attorney to approve the application for publication. There are no other issues on appeal.

4.0 Applicant's Arguments

**4.1 BANANA is Not Merely Descriptive of Air Fragrancing Preparations; Room
Fragrances**

The Examining Attorney stated in the Office Action that the word BANANA “merely describes the scent of the goods.” However, Applicant respectfully submits that Applicant is not using BANANA to describe the scent of the Applied-for Products (*air fragrancing preparations; room fragrances*). BANANA, when used in the manner and context at issue, does not immediately or directly describe a characteristic of the Applied-for Products, and instead requires consumers to engage in imagination or thought process to reach a conclusion, if at all, about the nature of the goods.

A merely descriptive mark immediately and directly conveys information regarding the nature, qualities, or characteristics of the goods or services in question. *See In re Gyulay*, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987); *In re Quik-Print Copy Shop, Inc.*, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980). A mark that does not describe the associated goods or services with any degree of particularity is not merely descriptive. *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (TTAB 1972).

Here, Applicant is not using BANANA to describe the scent of the Applied-for Products. Rather, by combining BANANA with the term BOAT, Applicant is using the phrase BANANA BOAT as a unitary phrase that services as a source indicator. The Examining Attorney, in support of the refusal, only submits evidence of third-party products in which the term

BANANA is used to *clearly refer to the scent of the fruit BANANA* (e.g., BANANA WALNUT CAKE LINEN & ROOM SPRAY, COCONUT AND BANANA, BANANA CREAM PIE BARN ROOM SPRAY, INTOXICATING BLEND OF BANANA, KIWIS, STRAWBERRIES, and PINEAPPLES, FRESH BANANA BLENDED WITH SWEET GRAPEFRUIT, and BANANABERRY SCENTSY ROOM SPRAY). Unlike the examples submitted by the Examining Attorney, Applicant is not using BANANA to refer to the scent of the Applied-for Products. To the contrary, BANANA, when combined with the term BOAT, does not immediately or directly describe a characteristic of the Applied-for Products, and instead requires consumers to engage in imagination or thought process to reach a conclusion, if at all, about the nature of the goods. As such, BANANA in the mark unitary mark BANANA BOAT cannot be merely descriptive of the Applied-for Products.

In addition to all of the foregoing, it should be noted that this is an intent to use application, and the identification of goods makes no reference to bananas or banana scents.

4.2 The Examining Attorney Has Not Established a Prima Facie Case that the Term BANANA is Merely Descriptive of Air Fragrancing Preparations and Room Fragrances

The Examining Attorney has the burden of showing that BANANA is merely descriptive of Applicant's goods, namely *air fragrancing preparation and room fragrances*. *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). To be merely descriptive, the primary significance of the term BANANA must describe a quality, feature, attribute or characteristic of the particular goods in connection with which the term is used.

Here, the Examining Attorney merely presents a dictionary definition of BANANA (i.e., a tropical plant of the genus *Musa*). In addition, the Examining Attorney submits evidence from

third-party online retail stores showing BANANA used to clearly refer to the scent of bananas (i.e., BANANA (TRUE) FRAGRANCE OIL and BANANA ROOM SPRAY). However, these examples raised by the Examining Attorney simply don't apply to Applicant's mark. Applicant is using the term BANANA in combination with the term BOAT, thereby creating an arbitrary and unitary phrase BANANA BOAT (*see* Section 4.4 of this Appeal Brief). BANANA BOAT has become widely recognized and is indeed famous, at least in the context of Applicant's suncare products. It is also a term used to refer to types of boats, as discussed below. The Examining Attorney has presented no evidence to support a finding that Applicant's customers would perceive the term BANANA in Applicant's well known mark BANANA BOAT as merely describing *air fragranting preparations; room fragrances*.

Thus, the Examining Attorney failed to establish a prima facie case that the term BANANA is merely descriptive of *air fragranting preparations and room fragrances*.

**4.3 Third-Party Evidence Supports a Finding that BANANA is Not Descriptive
When used in Connection With the Applied-for Products**

Any finding that the term BANANA is merely descriptive and the requirement that Applicant disclaim this term is contrary to prior Trademark Office treatment of marks containing BANANA. Prior practice shows that the Trademark Office has not treated the term BANANA to be descriptive when used in connection with consumer goods similar to *air fragranting preparations and room fragrances*.¹

¹ Many registrations on the Principal Register contain the term BANANA without a disclaimer of the exclusive right to use that term, including the following:

1. BANANA MOON; Reg. No. 3,534,514 for *toilet water, perfumes, perfumed soaps, essential oils, shaving preparations, deodorants for body care, cosmetic sun-tanning preparations, hair lotions, body creams, room spray*;

For example, Banana Republic (Apparel), LLC has registered its mark BANANA REPUBLIC in connection with *aromatic candles*. The Trademark Office did not require Banana Republic, LLC to disclaim the exclusive right to use BANANA, probably because the Trademark Office recognized that consumers will not perceive the term BANANA in the mark BANANA REPUBLIC as somehow merely describing the scent of *aroma candles*. Instead, the Trademark Office acknowledged the fact that the term BANANA, as used in Banana Republic's mark and in the context of Banana Republic's goods, has a greater meaning in context and as a source indicator other than the fact that the goods could potentially have the scent of bananas. Like Applicant's mark BANANA BOAT, the mark BANANA REPUBLIC is a phrase that means more than the mere sum of its parts. Applicant's mark is not a reference to banana scented/flavored boats any more than Banana Republic's mark is a reference to a banana scented/flavored republic.

Thus, contrary to the Examining Attorney's assertion, Applicant respectfully submits that BANANA, as part of the unitary mark BANANA BOAT, is capable of serving as a distinctive source identifier, capable of registration on the Principal register without a disclaimer, and does not *immediately* describe Applicant's Applied-for Products. While one Trademark Office

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2. BANANA REPUBLIC; Reg. No. 2,048,367 for *toilet water, shower gel, moisturizing body lotion, soap; aromatic candles*;
 3. BANANA REPUBLIC MODERN; Reg. No. 2,459,986 for *cologne*;
 4. BANANA NUT BREAD; Reg. No. 2,319,762 for *hair products, namely, shampoos; and bath products, namely gels, and bubble bath*; and
 5. ELECTRIC BANANA; Reg. No. 2,925,265 for *cosmetics, hair dyes, hair colors*.

Printouts from the Trademark Office's website with information regarding these registrations were submitted to the Trademark Office with the Office Action Response filed on December 18, 2014. These examples support Applicant's argument that the word BANANA is not merely descriptive; but, rather, is distinctive.

Examining Attorney is not expressly bound by decisions made by other Examining Attorneys in different cases, Applicant can conceive of no reasonable justification distinguishing these other cases from the present case and requiring a disclaimer of the term BANANA.

4.4 BANANA BOAT Should Be Viewed as a Whole and Not Dissected Into Its Component Parts

Even if, for the sake of argument, the term BANANA was descriptive of the Applied-for Products (which it is not), requiring a disclaimer would still be improper because Applicant's BANANA BOAT comprises a unitary phrase, and is therefore not subject to a disclaimer requirement.

In considering Applicant's mark BANANA BOAT, the Examining Attorney impermissibly dissected the mark into its component parts, and analyzed the term BANANA alone, rather than considering the mark BANANA BOAT as a whole. A mark is unitary when it creates a commercial impression separate from any unregistrable component. TMEP § 1213.05; *see Dena Corp. v. Belevedere Int'l Inc.*, 221 USPQ2d 1047, 1052 (Fed. Cir. 1991) (a composite mark is unitary when its components create a single and distinct commercial impression or an inseparable whole). It is well settled that an applicant need not disclaim a term, even when it is descriptive of the relevant goods and/or services, if the mark as a whole creates an overall commercial impression that is more than the mere sum of its parts, and the descriptive nature of the relevant term is thus not perceived by consumers viewing the mark. TMEP § 1213.05; *Dena Corp.*, 221 USPQ2d at 1051-52 (when the composite mark is a unitary mark, a disclaimer is not necessary because the purportedly descriptive matter does not comprise an unregistrable component of a mark otherwise registrable). Whether a composite mark is unitary is a subjective

determination based on the commercial impression engendered by the mark. *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981).

In this case, Applicant's BANANA BOAT mark is not a simple combination of two common descriptive terms which, when combined, merely describe a product or service. Rather, BANANA BOAT creates a distinct commercial impression separate from the term BANANA or BOAT. Even assuming *arguendo* that BANANA has descriptive significance, when the term BANANA is combined with the term BOAT (which it does not), average prospective consumers will recognize BANANA BOAT as a unique phrase in the context of the Applied-for Products. Applicant has been using its well-known trademark BANANA BOAT as a source indicator for almost 40 years. In addition, the term "banana boat" refers to a type of boat. Thus, consumers will perceive BANANA BOAT as a unitary mark, not a combination of two separate and independent components. The sum of the two terms equals more than its component parts. Consumers will not view the term BANANA in isolation or as a description of the relevant goods.

Additionally, the disclaimer of a descriptive term is generally not required if the mark creates an incongruity. *See* TMEP § 1213.05(d) (stating: "If two or more terms are combined in a mark to create an incongruity, ... the mark is unitary and no disclaimer of nondistinctive individual elements is necessary").

Here, the mark is unitary by virtue of its incongruity. Consumers would not be likely to conclude that BANANA BOAT describes a *banana scented* BOAT, and indeed inflatable recreational boats sometimes referred to as "banana boats" are not known for having any particular scent. If anything, "banana" is a reference to the shape of such boats, which of course has nothing to do with Applicant's mark. *See In re On Technology Corp.*, 41 U.S.P.Q.2d 1475

(TTAB 1996) (reversing a descriptiveness refusal to register the mark AUDITTRACK for software that audit and tracks activity on a computer network because “[l]iterally, such mark does not audit a track or track an audit. In consequence thereof, purchasers and prospective customers would have to pause and reflect on the significance of the combined designation ‘AUDITTRACK’ in order to understand” its meaning). The phrase BANANA BOAT has no logical relationship whatsoever to the Applied-for Products. This incongruity results in an arbitrary designation which creates a separate commercial impression of something more than the whole of its parts. TMEP § 1213.05.

Given the above arguments, Applicant's BANANA BOAT mark creates a commercial impression which is “something more than the sum of its parts,” TMEP § 1213.05, and therefore comprises a unitary mark. Accordingly, the term BANANA cannot be deemed subject to a disclaimer requirement, even if that term were in fact descriptive of the Applied-for Products (which it is not).

4.5 Any Doubts as to Descriptiveness Must Be Resolved in Applicant's Favor

Applicant believes it has established that the term BANANA, when used in combination with the term BOAT in an arbitrary manner, is not merely descriptive of *air fragancing preparations and room fragrances*. Any doubt with respect to the issue of descriptiveness should be resolved in Applicant's behalf. See *In re Penwalt Com.*, 173 USPQ 317, 319 (TTAB 1972) (noting that although its conclusion of registrability was not “free from doubt...the doubt should be resolved in favor of the applicant.”); *In re Women's Publishing Co.*, 23 USPQ2d 1876, 1877 (TTAB 1992) (finding that, for a magazine featuring articles on decorating, the mark DECORATING DIGEST was not descriptive and noting that “in accordance with precedent, we must resolve any reasonable doubt in favor of applicant”); *In re Merrill Lynch, Pierce, Fenner*

and Smith, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987) (“It is incumbent on the Board... to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent”).

For the reasons discussed in this Appeal Brief, Applicant believes there is no doubt that BANANA should not be disclaimed. But to the extent that there are any doubts on the issue, those should be resolved in Applicant’s favor.

5.0 No Oral Hearing Is Requested.

Applicant does not request an oral hearing.

6.0 Conclusion

In view of the foregoing, Applicant respectfully submits that the term BANANA is not merely descriptive and the mark BANANA BOAT is entitled to registration on the Principal Register without disclaiming BANANA. Therefore, the disclaimer requirement is improper and should be reversed.

Respectfully submitted,

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